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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/690,075 | 10/20/2003 | Toshifumi Masaki | 1232-5178 | 4876 |
| 27123 7590 10/16/2008 MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101 | | | | |
| EXAMINER HOEKSTRA, JEFFREY GERDEN | | | | |
| ART UNIT 3736 | | PAPER NUMBER | | |
| NOTIFICATION DATE 10/16/2008 | | DELIVERY MODE ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com
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Office Action Summary

Application No.

10/690,075

Applicant(s)

MASAKI, TOSHIFUMI

Examiner

JEFFREY G. HOEKSTRA

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/29/2008 & 10/09/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/29/2008 has been entered.

Notice of Amendment

2. In response to the amendment filed on 09/29/2008 and 10/09/2008, amended claim(s) 1 and canceled claim(s) 9-10 is/are acknowledged. The current rejections of the claim(s) 1 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. Claim 1 as amended positively recites "a CPU configured to *predict* a maximum output value of an output signal". In support thereof, Applicant solely references page 14 line 18 - page 16 line 20 of the instant specification. The Examiner notes there is no support for the claimed subject matter comprising: a CPU configured to "predict" a maximum output value of an output signal. Conversely, the invention is described such that "the peak value of the deformation signal is *detected* based on the data of the deformation signal stored in the memory" (page 14 lines 18-20). Because a CPU detecting a signal is not a CPU predicting a signal, the amended subject matter of claim 1 comprises new matter and as such should be cancelled.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi (US 5,727,551) in view of Katsuragi (US 5,469,233).

8. Takagi discloses a non-contact tonometer (Abstract, column 2 lines 43-64), comprising:

- an alignment light source (11) (as best seen in Figure 1) for emitting a light flux for alignment of a cornea (C) of an eye (E) to be examined (column 3 lines 63-67);
- a projection optical system (15 and 16) (as best seen in Figure 1) for projecting the light flux from the alignment light source onto the cornea of the eye to be examined (column 27-39);
- an image capture means for sensing an image (27) (as best seen in Figure 1) obtained from a reflected alignment light flux which is the light flux projected onto and reflected by the cornea of the eye to be examined (column 4 lines 23-26), wherein the image capturing means for sensing an image senses the image after completing the alignment between the cornea of the eye to be examined and the non-contact tonometer (column 7 lines 1-30);
- a means for deforming the cornea of the eye to be examined (70) (as best seen in Figure 4) by blowing pressurized air onto the cornea of the eye to be examined (column 1 lines 34-54 and column 4 lines -11);
- an intraocular pressure measurement light source (31) (as best seen in Figure 1) for emitting a measurement light flux for measurement of an intraocular pressure of the eye to be examined (column 4 lines 27-39), wherein the projection optical system projects the measurement light flux from the intraocular pressure measurement light source onto the cornea of the eye to be examined (as best seen in Figure 1);
- an intraocular pressure measurement light receiving means for detecting a reflected measurement light flux (54) (as best seen in Figure 1) which is the measurement

light flux projected onto and reflected from the cornea of the eye to be examined (column 5 lines 49-64); and

- a CPU (87) (column 6 line 27 – column 8 line 11) (as best seen in Figure 4) configured to calculate change in pressure over time of the intraocular pressure.
9. Takagi discloses the claimed invention as set forth above except for expressly disclosing the CPU configured to predict a maximum output value of an output signal which is output from the intraocular pressure measurement light receiving means on the basis of an intensity of the image, at a time of completing the alignment, sensed by the image capture means, and to execute error processing in a case that an output value of the output signal from the intraocular pressure light receiving means exceeds the predicted maximum output value.
10. Katsuragi teaches a non-contact tonometer, comprising *inter alia*: a CPU (as best seen in Figure 3) configured to predict a maximum output value (54) of an output signal which is output from the intraocular pressure measurement light receiving means (17) on the basis of an intensity of the image , at a time of completing the alignment, sensed by the image capture means, and to execute error processing (55) in a case that an output value of the output signal from the intraocular pressure light receiving means exceeds the predicted maximum output value (53).
11. The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Because both Takagi and Katsuragi teach CPU configurations for determining intraocular pressure with a non-contact tonometer, it

would have been obvious to one skilled in the art at the time of the invention to substitute one CPU configuration for the other to achieve the predictable results of increasing the efficacy of a non-contact tonometer to provide an accurate intraocular pressure measurement.

Response to Arguments

12. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY G. HOEKSTRA whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.H./

Jeff Hoekstra

Examiner, Art Unit 3736

/Max Hindenburg/

Supervisory Patent Examiner, Art Unit 3736